

REMARKS

In response to the rejection of claims 1-3, 7, 8, and 10-19 and under 35 USC 101 because the claimed invention is allegedly directed to nonstatutory subject matter, applicants note that independent claim 1, upon which claims 2, 3, 7, 8, and 19 depend, is directed to an authentication server including a memory, reception arrangement and a redirection arrangement, all of which are structure and not merely a program. Similarly, claim 11, upon which claims 12-18 depend, requires an authentication server arrangement to include a receiver arrangement and a connector redirector arrangement. A program, by itself, is incapable of being a memory, a reception arrangement or a redirection arrangement. All these elements are hardware or at least require some hardware.

The Office Action implies that a combination of hardware and software is not statutory subject matter. This is not the law. MPEP, Section 2106, specifically states that a combination of hardware and software is patentable subject matter and cites, in support of this statement, *In re Lowry* 32 F.3d 1579, 1583, 32 USPQ2d 1031, 1034-35 (Fed. Cir. 1994) and *In re Warmerdam* 33 F.3d 1354, 1361-62, 31 USPQ2d 1754, 1760 (Fed. Cir. 1994). Such subject matter is properly considered as a machine under 35 USC 101. The examiner must support his position on this issue or withdraw the rejection.

Claim 10 now requires a physical information medium or a storage device adapted to be loaded into and executed by an authentication server. The medium or storage device is required to include computer readable coded indicia representing a program. Such subject matter is properly considered as an article of manufacture under 35 USC 101.

The office action refers to the statement in paragraph 0075 of the published application which states: "the invention applies equally to a computer program adapted to implement the invention." This phrase means that the invention can use a computer program to perform part of the invention. A computer program, per se, is not able alone to provide the structure defined by the claims as they are now directed to an

authentication server. The claims, as now submitted are directed to an authentication server that obviously includes hardware, as discussed above. In addition, paragraph 0076 of the published application says the steps of the method are determined by instructions of an authentication selection program incorporated into an authentication server SA, and the method of the invention is performed when this program is loaded into a computer (or processor included in the authentication server) whose operation is then controlled by the execution of the program. Paragraphs 0075 and 0076 refer to claims 1 and 9, as originally submitted, which claims did not include the reception arrangement, memory and connection redirecting arrangement of amended claim 1.

In response to the rejection of claims 18-20 as set forth in the paragraph bridging pages 4 and 5 of the Office Action, there is an error in Applicants' remarks in the amendment filed April 2, 2009, on page 8, first paragraph, lines 6-7 and errors in claims 18-20 that were submitted with that amendment. The second sentence in the first paragraph on page 8 should have read as follows:

The independent claims have been amended so they are directed to the second embodiment described in connection with Fig. 3 and paragraphs 0057 to 0070 of the published application and the spirit of claim 5, as previously submitted, wherein there is no connection between the user terminal T and the ~~authentication~~ service server ~~SASE~~, as in step E2 of figure 2 (according to the first embodiment), before the authentication of the user (step F13 corresponding to step E10) and thus there is one connection redirecting arrangement only after the authentication of the user.

This is in harmony with page 11, and the beginning of the third paragraph of the Applicants' remarks in the April 2, 2009, amendment which states:

"For each service request in claim 1, no connection between the terminal and the service server designed by the selected provider identifier is established (Fig. 3, step 16) before authenticating the user [Fig. 3, 0061; and Fig. 3, F16 after F4; 0067, 0068]."

"In the claimed authentication server and the claimed method for automatically selecting one of a plurality of authentications, there is no connection between the user terminal and the service server corresponding to the selected provider identifier before the authentication of the user, in comparison with the operation 62 and 64 in Ritola."

Claims 18-20 are therefore amended herein to correct the previous errors and the errors in the remarks accompanying the April 2, 2009 remarks should be ignored, based on the previous discussion in the present amendment.

In response to the rejection of claims 1-3 and 5-20 under 35 USC 103(a) as being unpatentable over Sawa et al., US Patent Publication 2003/0097593 in view of Ritola et al., US 2005/0289341, applicants rely on the argument set forth in the prior response, as modified above, and have the following comments.

All of applicants' claims indicate there is no connection between the user terminal and the service server. The second full paragraph on page 7 and the only full paragraph on page 8 of the office action respectively refer to (1) paragraph 0053 of Sawa and (2) to paragraph 0048 of Ritola. Paragraph 0053 of Sawa refers to a request for the Web application from a user terminal that is received by a Web server 13, i.e. a service server, to select an authentication method suitable for a user terminal. Paragraph 0048 of Ritola (Fig. 4) indicates user terminal 4 provides access to a service contacts service provider 6, i.e. a service server, which sends an authentication request via the user terminal to identify provider 8 selected (1) by the user or (2) automatically by the user terminal to authenticate the user as a function of authentication information sent from the user terminal to identify provider 8.

Therefore, Sawa and Ritola fail to disclose the requirement of the independent claims for there to be no connection between the user terminal and the service server before authenticating the user, i.e. a reception arrangement included in an authentication server for receiving from said terminal a provider identifier (i.e. a service server identifier) selected in said terminal in response to a connection set up between said user terminal and said authentication server without any prior connection between said user terminal and one of said service servers, before authenticating the user.

Because independent claims 1 and 9 are not rendered obvious by Sawa in combination with Ritola, the remaining claims, which depend on claims 1 and 9, are allowable.

Early issuance of a Notice of Allowance is courteously solicited.

The Examiner is invited to telephone the undersigned, Applicant's attorney of record, to facilitate advancement of the present application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

LOWE HAUPTMAN HAM & BERNER, LLP

/Allan M. Lowe/

Allan M. Lowe
Registration No. 19,641

USPTO Customer No. 22429
1700 Diagonal Road, Suite 300
Alexandria, VA 22314
(703) 684-1111
(703) 518-5499 Facsimile
Date: October 19, 2009
AML/cjf